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Robin M. Silva  
Dorsey & Whitney LLP  
Intellectual Property Department  
Four Embarcadero Center, Suite 3400  
San Francisco, CA 94111-4187

EXAMINER

SWARTZ, RODNEY P

ART UNIT

PAPER NUMBER

1645

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/763,413

Applicant(s)

SPANGLER ET AL.

Examiner

Rodney P. Swartz, Ph.D.

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 3February2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 19 and 20 is/are rejected.
- 7) ☒ Claim(s) 1, 4 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2September2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Applicants' Response to Restriction Requirement, received 3 February 2005, is acknowledged.

Applicants elect, with traverse, Invention I, claims 1-9 and 18-20, drawn to dendrimer composition and method of making classified in class 424, subclass 130.1.

No arguments/grounds of traversal were put forth by applicants. Therefore, the requirement is still deemed proper and is therefore made FINAL.

Claims 10-17 and 21-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

Claims 10-17 and 21-24 have been cancelled.

2. Claims 1-9 and 18-20 are pending and under consideration.

### **Specification**

3. The abstract of the disclosure is objected to because line 4 contains an opening parenthesis without a closing parenthesis, i.e., (sometimes. Correction is required. See MPEP § 608.01(b).

4. The disclosure is objected to because of the following informalities:

Page 1, line 6, there is no subject for the opening sentencing beginning "In the wake",

Page 2, line 8, "of from" should be "from",

Page 7, lines 3, 7, and 11, "addition" should be "additional",

Page 10, line 5, "etc. ; » should be "etc).",

Page 11, line 8, "pesius" should be "pestis",

Page 12, line 1 "tethers" should be "tether"; line 6, "viruses that may" should be

"viruses may"; line 21, "B. lambliaY.pestis" should be "Y.pestis",

Art Unit: 1645

Page 13, line 12, "general" should be "generally"

Page 18, line 5, "fouth" should be "fourth"; line 8, what is "mondisperse"?,

Page 19, line 2, "strepavidin" should be "streptavidin",

Page 26, line 3, "too" should be "tool",

Page 27, line 14-15, should "could be immobilized" be deleted?

Page 28, line 2, insert "of" between production and large,

Page 30, line 1, what are "nuceloties"?

Appropriate correction is required.

### **Claim Objections**

5. Claim 1 is objected to because of the following informalities: line 4, "at least a first a" should be "at least a first". Appropriate correction is required.
6. Claim 4 is objected to because of the following informalities: line 2, "portion" should be "portions". Appropriate correction is required.
7. Claim 18 is objected to because of the following informalities: line 3, "a aldehyde" should be "an aldehyde". Appropriate correction is required.

### **Claim Rejections - 35 USC § 112**

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1645

9. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is drawn to a composition comprising three components. There is no recitation that the terminal dendrimer, linker and functional moiety are in any attached to each other. This is in contrast to the specification which teaches a structure wherein the three components are physically attached to each other. It is unclear if applicants are claiming the invention described in the specification or a different form of the components.

Claims 2-9 depend from claim 1, but do not clarify the issue.

10. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 depends from claim 1. Claim 2 defines the linker of claim 1 "wherein said linker comprises a second hydrophilic polymer". It is unclear if the components of claim 1 are also present in the linker. It is recommended that claim 2 recites "wherein said linker further comprises" in order to clarify the structure of the linker.

11. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 depends from claim 1. Claim 3 recites "wherein said hydrophilic polymer comprises a polyethylene glycol polymer". Because claim 1 recites "at least a first hydrophilic polymer", it is unclear if in embodiments with multiple hydrophilic polymers, all polymers are PEG or just one or only the first polymer.

Art Unit: 1645

12. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites that two PEG polymers "portion" are separated by a rigid rod "portion". It is unclear what is meant by "portion".

13. Claims 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, because claim 19 recites the limitation "method of Claim 18 wherein the binding domain of said first compound is a binding moiety" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim because claim 18 does not recite "binding domain", only "first compound". Claim 20 depends from claim 19, but does not clarify the issue.

### **Conclusion**

14. No claims are allowed.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney P. Swartz, Ph.D., Art Unit 1645, whose telephone number is (571) 272-0865. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM EST.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Lynette F. Smith, can be reached on (571)272-0864.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

Art Unit: 1645

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



RODNEY P SWARTZ, PH.D  
PRIMARY EXAMINER  
Art Unit 1645

April 29, 2005